

REMARKS

I. CLAIM STATUS

Prior to the above amendment, claims 35-83 were pending. Claims 40, 51-59, and 78-83 have been withdrawn from consideration by the Office pursuant to a Requirement for Restriction. See Office Action at 2. Without prejudice or disclaimer, claim 35 has been amended to incorporate the elements of claim 62. Claim 62 is therefore cancelled. Further without prejudice or disclaimer, claims 45, 46, 49, 50, 60, 61, and 63-67, 69, and 70 have been amended to maintain strict antecedent basis and to depend from a pending claim, and claim 68 has been amended to recite “isononyl isononanoate” instead of “at least one sparingly polar oil.”

Support for the above amendments may be found in the as-filed specification and claims. No issue of written description is raised.

Applicant responds to the issues raised in the Office Action as follows.

II. PRIORITY INFORMATION

The Office states that “[t]his application is a 371 application of PCT/FR02/03801 which claims priority to French applications 02/00885 and 02/02358. French application 02/00885 has been submitted and is in compliance, however 02/02358 has not.” Office Action, page 3.

In response, Applicant submits herewith a certified translation of FR0200885. In view of this submission, Applicant believes that her claim of priority to French Application No. FR0200885 is perfected. Applicant therefore submits that this application is entitled to the filing date of FR0200885, i.e., January 24, 2002.

III. RESPONSE TO CLAIM REJECTIONS

A. The 35 U.S.C. § 112, second paragraph rejection is moot

The Office rejects claims 68 under 35 U.S.C. § 112, second paragraph as allegedly unclear. See Office Action, page 3. Applicant respectfully disagrees. Nonetheless, without prejudice or disclaimer, Applicant has amended claim 68 to replace “sparingly polar oil” with isononyl isononanoate, in an effort to expedite the prosecution of this application.

In view of this amendment, Applicants submit that the 35 U.S.C. § 112, second paragraph rejection is improper, and should be withdrawn.

B. The 35 U.S.C. § 103(a) rejection is improper, at least because the ‘969 patent is not available prior art per 35 U.S.C. § 103(c)

The Office rejects claims 35-39, 41-50, and 60-77 under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,464,969 to De La Poterie (the ‘969 patent”) in view of U.S. Patent No. 5,843,407 to El-Nokaly (“El-Nokaly”) (*Id.* at 4-6). Office Action, pages 4-8. Inasmuch as this rejection pertains to claim 62 it is moot, as claim 62 is now cancelled. With respect to the pending claims, Applicant respectfully disagrees with and traverses this rejection, at least because the ‘969 patent is not available as prior art against this application per 35 U.S.C. § 103(c).

As explained above in section II, Applicant has perfected her claim of priority by filing a certified translation of French priority application, No. FR0200885. Applicant therefore submits that this application is entitled the benefit of the filing date of French

application no. FR0200885, i.e., January 24, 2002.

The '969 patent was published on October 15, 2002 (i.e., after January 24, 2002), but has an effective filing date of June 15, 2001 (i.e., before the January 24, 2002). Thus, the '969 patent is only potentially available against this application as a prior art reference under 35 U.S.C. § 102(e).

35 U.S.C. § 103(c) states that effective November 29, 1999, subject matter that qualifies as prior art only under 35 U.S.C. § 102(e) is disqualified as prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. See M.P.E.P. § 706.02(I)(2)(II).

STATEMENT REGARDING OBLIGATION OF ASSIGNMENT

The '969 patent is disqualified as prior art under 35 U.S.C. § 103(c), because the present invention and the '969 patent were, at the time the invention was made, subject to an obligation of assignment to the same person, i.e., L'Oréal S.A., as evidenced by the assignment information recorded for the '969 patent recorded at REEL: 012249, FRAME: 0755 on October 9, 2001, and the assignment information recorded for the instant application at REEL: 016372, FRAME: 0479 on February 15, 2005. See M.P.E.P. § 706.02(I)(2)(II). Accordingly, Applicant respectfully submits that the Office cannot rely upon the '969 patent to support the pending § 103 rejection.

Therefore, because the '969 patent does not qualify as legally valid prior art against the present application under 35 U.S.C. § 103(a), Applicant respectfully submits that the rejection is improper and should be withdrawn.

C. Obviousness-type Double Patenting Rejections

On pages 9-11 of the Office Action, the Office twice rejects claims 35-39, 40-50, and 60-77 under the judicially created doctrine of non-statutory obviousness-type double patenting. The two rejections are based on a combination of the '969 patent with: a) a combination of U.S. Patent No. 6,949,504 (the "'504 patent") and El-Nokaly; or b) a combination of U.S. Patent No. 7,129,276 (the "'276 patent") and El-Nokaly. See Office Action, pages 9-11. Further, the Office identifies U.S. Application Nos. 10/502,447 and 11/147,236 as "[raising] similar obviousness-type double patenting issues." *Id.* at 11.

In response, Applicant respectfully requests that the Office reconsider the Double Patenting rejections in view of the above claim amendment. Applicant notes that neither the '504 patent nor the '276 patent claim a makeup composition comprising the claimed combination of "at least one liquid fatty phase structured with a mixture of at least one semi-crystalline polymer having an organic structure selected from low melting polymers having a melting temperature of less than 50° C, and at least one semi-crystalline polymer having an organic structure selected from high-melting polymers having a melting temperature of at least 50° C . . . at least one colorant; and . . . at least one volatile oil . . ." as recited in claim 1. In addition, the Office has not provided a tenable rationale explaining *why* one of ordinary skill would see any reason

to modify the claims of the '504 patent or the '276 patent in an attempt to arrive at the claimed invention.

For at least the foregoing reasons, Applicant respectfully requests that the Office reconsider and withdraw the applied obviousness type double patenting rejections.

IV. CONCLUSION

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06 0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By: 

Nikolas J. Uhrir
Reg. No. 62,201

Dated: August 23, 2009